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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/552,879	04/20/2000	John Carnahan	47004.000056	5010

21967 7590 04/26/2005

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INTELLECTUAL PROPERTY DEPARTMENT
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EXAMINER

CHENCINSKI, SIEGFRIED E

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 04/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No.	Applicant(s)	
	09/552,879	CARNAHAN ET AL.	
	Examiner	Art Unit	
	Siegfried E. Chencinski	3628	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 25 March 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____
Claim(s) objected to: _____
Claim(s) rejected: 1-40.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.


HYUNG SOUH
SUPERVISORY PATENT EXAMINER

Continuation of 3. NOTE: the new issues are raised by the amendments to claims 21, 27, 28 and 34. Each of these claims as they now stand require additional examination and, possibly additional search, because the amended limitations are not mere restatements of existing or canceled claims.

Continuation of 11. Other: a) Contrary to Applicant's argument, Applicant's response to the last non final rejection Action contains an amendment to claim 1 which necessitated the addition of the Kurtzman reference. Such an amendment to a claim permits the application of a final rejection if other considerations also call for a final rejection.

b) Regarding Applicant's expansion of his prior argument that the Reese reference is improper prior art because Reese:

(1) Applicant repeats his argument that Reese teaches away from Levine (p. 9, ll. 1-2p. 11. l. 1 - p. 13, l. 27). Applicant is referred to the detailed response to this argument in the last Office Action in "Response to Arguments", item B, pp. 11-12. The examiner respectfully replies that the examiner was not picking and choosing in citing W.L. Gore vs Garlock. The examiner read the opinion and found that the relevant aspect of the opinion turned on the court's finding that a technical error had been argued in the justification of an obviousness combination of two teachings. The court finding of a technical distinction in this case could not be clearer. The court found that the combination of the properties of two unrelated polymers was technically incompatible and thus the teachings could not be properly combined. Thus the court followed common sense logic.(2) Applicant argues that Reese is improper because "it would render Reese unsatisfactory for its stated purpose" (P. 10, ll.).

(2) Applicant argues that one or both references would be rendered unsatisfactory for its stated purpose (p. 9, ll. 2-3, Reese - p. 10, ll. 3-18).

(3) Applicant argues that the combination would change the reference's principle of operation, or the principle of operation of the combined reference (p. 10, ll. 19-20, 20-27).

Regarding arguments b) (2) and b) (3), the examiner wishes to respectfully point out that Applicant's invention and the Levine and Reese reference, and, for that matter, the Kurtzman reference, all are practices of art in the same area of art. They are therefore combinable for that reason. Further, individual method components of art are combinable in the business methods arts because, unlike in an art areas such as chemistry, biology or materials, the combination of business method steps does not affect the combined method steps if such a changed effect is not intended. The combination of two business method steps performed through a computer program are fundamentally different from the combination of two chemicals or from the behavior of two different materials under the same stimulus. Manipulation of materials or chemicals cannot be prejudged, whereas the performance of computer software programs can be combined in numerous ways without altering the performance of the components if performance alteration is not intended. the computer hardware may crash from being overloaded, and computer software may crash from programming errors, but conceptually, the combination can be expected to keep performing as it was designed to perform. Also, Reese does not change Applicant's invention by requiring such things as hardware components which are not present in Applicant's invention. Further, "[T]he PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his [or her] claimed product. Whether the rejection is based on inherency' under 35 U.S.C. 102, on prima facie obviousness' under 35 U.S.C. 103, jointly or alternatively, the burden of proof is the same...[footnote omitted]." The burden of proof is similar to that required with respect to product-by-process claims. In re Fitzgerald, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980) (quoting In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977)). In this case, Applicant must demonstrate specifically why the combination used by the examiner's rejection will not work in the manner of Applicant's invention. Applicant has thus far not offered such proof.